Rejection under 35 U.S.C. §101 (Non-Statutory Invention)

The Examiner asserts that the instant claims are "drawn to a non-tangible mathematical invention. No production or change in actual material is seen...." Applicants emphatically disagree with this assessment.

MPEP §706.03(a) sets forth examples of subject matter that is not considered statutory under 35 USC §101. These are 1) printed matter, 2) naturally occurring articles and 3) scientific principles. Furthermore, it is stated in MPEP §2106 IV.A: "The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena." Clearly, the presently claimed invention does not fall into any of these categories; it falls into one of the "four statutory categories of invention," namely, processes. It is further provided in MPEP §2106 IV.B.1 that "[I]n practical terms, claims define nonstatutory processes if they: -consist solely of mathematical operations without some claimed practical application...." Again, the present claims do not define such a process.

While the instant invention does use mathematics and the computational power available today, it is completely inappropriate for the Examiner to deem the invention to simply

be "mathematical." Applicants are not claiming a mathematical formula or anything else "mathematical" per se. The claimed invention, a process within the meaning intended in the statute, cannot by any means be said to consist solely of steps that one must follow to solve a mathematical formula or algorithm. Rather, the claimed process is one in which a number of steps are combined to design and produce polypeptides with great, evident potential for use in the real world. Furthermore, the claimed design method allows for the immediate elimination of myriad undesirable possibilities, thus saving considerable expenditure of time, money and effort.

As already pointed out in Applicants' last response, submitted April 26, 2005, the "tangibility" of the present invention is seen on many levels in the application as filed, and this disclosure is further enhanced by the showing provided in the Declaration of Professor Ned Wingreen provided with, and discussed in, said last response. Again, as previously pointed out, the data provided in the Wingreen Declaration demonstrate the design and production of a polypeptide with folding properties that are on a par with those which would be observed in a naturally occurring molecule. [See Wingreen Declaration, pages 5-7, including Figures 3-5]. Thus, the present invention cannot be regarded as a nontangible mathematical one.

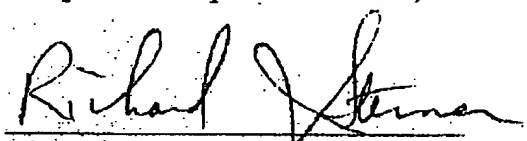
The claimed invention, even without the support of the Wingreen Declaration, cannot be viewed as nonstatutory under 35 U.S.C. §101. However, even if the Examiner was of a different mind before, the combination of the disclosure provided in the application as originally filed and the additional support provided in Applicants' April 26, 2005 Amendment and Response in the form of the Wingreen Declaration cannot be denied.

Applicants now await what they desired in the first place, what they are fully entitled to and what is long overdue: a complete examination and, barring allowance, a response from the Examiner that at least provides the status of the application with respect to all of the outstanding issues. Such consideration is respectfully requested.

No fees should be due in connection with this communication. However, should it be determined that a fee is required for any reason, the Commissioner is hereby authorized to charge it to Deposit Account No. 23-1703.

Dated: August 29, 2005

Respectfully submitted,



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